

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
:
Hiroki YAMAMOTO *et al.* : Confirmation No. 3549
:
U.S. Patent Application No. 10/705,228 : Group Art Unit: 1734
:
Filed: November 12, 2003 : Examiner: Kimberly Keil McClelland

For: PROCESS AND APPARATUS TO ATTACH ELASTIC MEMBERS TO
DISPOSABLE WEARING ARTICLE BEING CONTINUOUSLY MANUFACTURED

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Attn: BOARD OF PATENT APPEALS AND INTERFERENCES

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Appellant hereby files this reply brief to the Examiner's Answer mailed February 4, 2009 and respectfully requests that the appeal be maintained.

Appellant respectfully traverses all Examiner's arguments indicated in the "Grounds of Rejection" and "Response to Argument" sections of the Examiner's Answer. In the following ARGUMENT section, Appellant will address the Examiner's arguments indicated in the "Response to Argument" and "New Grounds of Rejection" sections *only*. Any remaining issues are believed to have been sufficiently and adequately treated in the Appeal Brief filed November 11, 2008.

STATUS OF CLAIMS

Same as Appeal Brief.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection of claims 1-3, 6-7, 9-10, 12-15, 19, 22-23, 25-27 are *substantially* the same as in the Appeal Brief,¹ except that the *listings* of claims being rejected under the First, Second, Sixth and Seventh grounds of rejection should be updated in view of the new grounds of rejection against claims 16-18 as manifested in the Examiner's Answer.²

All grounds of rejection are presented, with appropriate correction, herein below for the Board's convenience of review.

A. First Ground of Rejection

Claims 9, 11 13, 15, 19 and 22 have been rejected under 35 U.S.C. 103(a) as being unpatentable over *Blenke* in view of *Syndikus*, *Uchida* and *Cordeiro*.

B. Second Ground of Rejection

Claims 1-2, 4, 6-7, 12, 14, 16-18 and 23 have been rejected under 35 U.S.C. 103(a) as being unpatentable over *Blenke* in view of *Syndikus*, *Uchida*, *Cordeiro* and *Herrmann*.

C. Third Ground of Rejection

Claim 3 has been rejected under 35 U.S.C. 103(a) as being unpatentable over *Blenke* in view of *Syndikus*, *Uchida*, *Cordeiro*, *Herrmann* and further in view of *Liu*.

D. Fourth Ground of Rejection

Claim 10 has been rejected under 35 U.S.C. 103(a) as being unpatentable over *Blenke* in view of *Syndikus*, *Uchida*, *Cordeiro*, and further in view of *Liu*.

¹ See Appeal Brief at pages 11-14.

² See Examiner's Answer at page 2, the last paragraph, and page 3, the first paragraph.

E. Fifth Ground of Rejection

Claim 24 has been rejected under 35 U.S.C. 103(a) as being unpatentable over *Blenke* in view of *Syndikus*, *Uchida* and *Herrmann* as applied to claims 1-2, 4, 6-7, 12, 14, and 23, and further in view of *Cordeiro*.

F. Sixth Ground of Rejection

Claims 9, 11, 13, 15, 19 and 22 have been rejected under 35 U.S.C. 103(a) as being unpatentable over *Blenke* in view of *Syndikus*, *Heikkila*, and *Cordeiro*.

G. Seventh Ground of Rejection

Claims 1-2, 4, 6-7, 12, 14, 16-18, 23 and 25-26 have been rejected under 35 U.S.C. 103(a) as being unpatentable over *Blenke* in view of *Syndikus*, *Heikkila*, *Cordeiro* and further in view of *Herrmann*.

H. Eighth Ground of Rejection

Claim 3 has been rejected under 35 U.S.C. 103(a) as being unpatentable over *Blenke* in view of *Syndikus*, *Heikkila*, *Cordeiro*, *Herrmann* and further in view of *Liu*.

I. Ninth Ground of Rejection

Claim 10 has been rejected under 35 U.S.C. 103(a) as being unpatentable over *Blenke* in view of *Syndikus*, *Heikkila*, *Cordeiro* and further in view of *Liu*.

J. Tenth Ground of Rejection

Claim 24 has been rejected under 35 U.S.C. 103(a) as being unpatentable over *Blenke* in view of *Syndikus*, *Heikkila* and *Herrmann* as applied to claims 1-2, 4, 6-7, 12, 14, 23 and 25-26, and further in view of *Cordeiro*.

ARGUMENT

Appellant respectfully traverses all grounds of rejection for the reasons detailed in the Appeal Brief and as additionally presented herein below.

Rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR International Co. v. Teleflex Inc.*, 550 U.S. at ___, 82 USPQ2d at 1396.

A. First Ground of Rejection

35 U.S.C. 103(a) rejection of claims 9, 11, 13, 15, 19 and 22 as being unpatentable over Blenke in view of Syndikus, Uchida and Cordeiro

Independent claim 15

a. The Examiner's response³ to Appellant's argument No. 1 in the Appeal Brief⁴ is noted.

The Examiner stated that the proposed combination of *Blenke* and *Syndikus* does not eliminate the sliding capability of *Blenke*. In other words, the Examiner stated that in the proposed combination of *Blenke* and *Syndikus*, the arm 42/44 of *Blenke* and the supports 44, 46, 47 would still be slidable along the parallel slides 48.⁵ Since the *Blenke* motor 82 is carried by slidable support 47 as best seen in FIG. 2A of *Blenke*, motor 82 in the proposed combination would also be slidable along the parallel slides 48. As a result, the axis of the rotary shaft of motor 82 would be necessarily slidable along the parallel slides 48, i.e., relative to the axes of the press rolls 72, 72 in FIG. 2 of *Blenke*.

Therefore, the proposed combination would fail to teach or suggest the claim feature that "an axis of said rotary shaft is stationary relative to the axes of said press rolls."

³ See Examiner's Answer at page 41.

⁴ See Appeal Brief at page 17, paragraph No. 1.

⁵ See *Blenke* at column 5 lines 26-28.

b. The Examiner's response⁶ to Appellant's argument No. 2 in the Appeal Brief⁷ is noted.

The Examiner argued that Blenke does not teach away from the proposed combination because Syndikus does not teach or suggest oscillations of great magnitude.

The Examiner's argument is not on point. The Examiner should have addressed what *Blenke* teaches, i.e., what disclosure of *Blenke* does not teach away from the proposed combination. The Examiner's argument regarding what *Syndikus* teaches (or does not teach) is irrelevant.

Appellant respectfully submits that in the proposed combination, the short-arm oscillations about pivot 84 in FIG. 2B of *Blenke* would be replaced with long-arm (between 47 and 84 in FIG. 2B of *Blenke*) oscillations since the motor 82 is placed on support 47 as best seen in FIG. 2A of *Blenke*. Such long-arm oscillations are undesirable⁸ and, therefore, a person of ordinary skill in the art would not have directly attached the shaft of motor 82 of *Blenke* with its oscillating arms as taught by *Syndikus* in the manner proposed by the Examiner.

c. The Examiner's response⁹ to Appellant's argument No. 3 in the Appeal Brief¹⁰ is noted.

The Examiner argued that specific gravity or bending modulus might be related to elastic patterns.

The Examiner's argument is not evidentially supported, despite Appellant's challenge.¹¹ In the absence of evidence (rather than arguments) showing that the art (rather than the Examiner's personal knowledge), prior to the present invention, recognized the claimed parameters as result-effective variables, the Examiner's optimization argument is not persuasive and should be withdrawn.

⁶ See Examiner's Answer at page 42.

⁷ See Appeal Brief at pages 17-18, paragraph No. 2.

⁸ See *Blenke* at column 1 lines 40-46, and column 7 lines 61-65.

⁹ See Examiner's Answer at page 43.

¹⁰ See Appeal Brief at pages 18-19, paragraph No. 3.

d. In response to the Examiner's arguments in Examiner's Answer at page 44, Appellant respectfully submits that (i) *Blenke* and *Syndikus* are not properly combinable for the reason detailed at section b. above, and that (ii) even if the references were combinable as proposed by the Examiner, the resulting device would still lack the claimed "axis of said rotary shaft is stationary relative to the axes of said press rolls" as detailed at section a. above.

Claim 22

Claim 22 is separately patentable, because the Examiner has not provided evidence of art-recognized result-effective variables, despite Appellant's request in the August 13, 2008 after-final Amendment, at paragraph 4.

B. Second Ground of Rejection

35 U.S.C. 103(a) rejection as to claims 1-2, 6-7, 12, 14, 16-18 and 23 under 35 U.S.C. 103(a) as being unpatentable over Blenke in view of Syndikus, Uchida, Cordeiro and Herrmann.

Independent claim 1

The rejection of claim 1 is traversed for at least the reasons detailed above at sections a-c with respect to claim 15 which includes similar limitations to claim 1. The rejection of claim 1 is further traversed for the following additional reasons.

e. The Examiner's response¹² to Appellant's argument No. 4 in the Appeal Brief¹³ is noted.

The Examiner stated that nothing in the cited passage¹⁴ of *Blenke* teaches away from the arm's horizontal arrangement. Appellant respectfully submits that although *Blenke* does not explicitly require a vertical arm arrangement, it inherently requires so. Since *Blenke* specifically requires the guides 44/46 to be maintained perpendicular to the curvilinear paths 26 and 28

¹¹ See Appeal Brief at page 19 the last paragraph.

¹² See Examiner's Answer at page 45.

¹³ See Appeal Brief at pages 22-23, paragraph No. 4.

which, as best seen in FIGs. 1 and 2A of *Blenke*, are horizontal, it necessarily and logically follows from the *Blenke* disclosure that the guides 44/46 must be vertically oriented as also best seen in FIG. 1 and 2A of *Blenke*. The reference teaches away from the horizontal arrangement imported from *Herrmann*.

f. The Examiner's response¹⁵ to Appellant's argument No. 5 in the Appeal Brief¹⁶ is noted.

Appellant respectfully disagrees with the Examiner's rationale for the reason detailed in the Appeal Brief, paragraph No.5 on page 23.

It should be further noted that claim 1 requires to actually oscillate the arm at the recited maximum acceleration, whereas the *Cordeiro* reference only discloses a capability of some servomotors to have such an acceleration. There is no reasonable expectation that the *Cordeiro* servomotors' capability would be successfully realizable in an actual plastic application process such as that disclosed by *Blenke*.

Claim 7

The Examiner argued that the claimed "deviation angle of 10° or less relative to a horizontal plane" would be met by the *Herman* "deviation angle of 0."

Appellant respectfully disagrees, because zero does not define a deviation angle. A plane or line that forms a zero angle with the horizontal plane does not deviate from the horizontal plane; it coincides with the horizontal plane instead. Claim 7 is thus separately patentable.

Claim 12

Claim 12 depends on claim 15 and is separately patentable from the other claims in the group for the reasons detailed with respect to claim 15.

¹⁴ Column 8 lines 36-41, and 50-55.

¹⁵ See Examiner's Answer at page 46.

¹⁶ See Appeal Brief at page 23, paragraph No. 5.

Claim 14

Claim 14 depends on claim 15 and is separately patentable from the other claims in the group for the reasons detailed with respect to claims 15 and/or 7.

Claim 16

Claim 16 is separately patentable from the other claims in the group for the reasons detailed at sections a. and b. above with respect to claim 15.

Claim 16 is also separately patentable because none of the applied references teach or suggest the claimed “maintaining an axis of said rotary shaft stationary relative to the axes of said press rolls while the elastic members are being fed and oscillated at the same time towards said nip.” *Blenke* as applied and modified by the Examiner would still require the shafts of motors 82 to be moveable along slides 48 during the elastic application.¹⁷

Claim 17

Claim 17 is separately patentable from the other claims in the group for the reasons detailed at sections a. and b. above with respect to claim 15.

Claim 18

Claim 18 is separately patentable from the other claims in the group for the reasons detailed at sections a. and b. above with respect to claim 15.

Claim 18 is also separately patentable because there is no evidence of record showing that the *Blenke* teaching of different patterns is indicative or suggestive of different stretching ratios as presently claimed.

¹⁷ See *Blenke* at, e.g., column 5 lines 41-45.

Claim 23

Claim 23 is separately patentable, because the Examiner has not provided evidence of art-recognized result-effective variables, as detailed *supra* with respect to claim 22.

C. Third-Sixth Grounds of Rejection

The Third through Sixth grounds of rejection are traversed for at least the reasons detailed *supra* and/or in the Appeal Brief.

D. Seventh Ground of Rejection

35 U.S.C. 103(a) rejection as to claims 1-2, 6-7, 12, 14, 16-18, 23 and 25-26 under 35 U.S.C. 103(a) as being unpatentable over Blenke in view of Syndikus, Heikkila, Cordeiro and further in view of Herrmann.

This rejection is traversed for at least the reasons detailed above with respect to the Second Ground of Rejection, since the prior art deficiencies discussed in with respect to the Second Ground of Rejection are not deemed curable by *Heikkila*.

Claims 1, 7, 12, 14, 23 are separately patentable over the references as applied by the Examiner as detailed *supra* and/or in the Appeal Brief.

Claim 25

Claim 25 is separately patentable from the other claims in the group for the reasons detailed with respect to claim 16.

The Examiner's argument¹⁸ that the proposed combination does not eliminate the sliding capability of *Blenke* further strengthens Appellant's position that *Blenke* as applied and modified by the Examiner would still require the shafts of motors 82 to be moveable along slides 48 during the elastic application.

¹⁸ See Examiner's Answer at page 48.

E. Eighth-Tenth Grounds of Rejection

The Eighth through Tenth grounds of rejection are traversed for at least the reasons detailed *supra* and/or in the Appeal Brief.

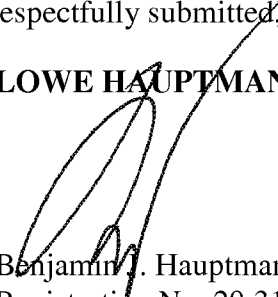
Consideration of this reply brief together with the previously submitted Appeal Brief is respectfully requested. Reversal of the Examiner's Final Rejection, in view of the arguments presented in the Appeal Brief and this Reply Brief, is believed appropriate and therefore courteously solicited.

If for any reason this Reply Brief is found to be incomplete, or if at any time it appears that a telephone conference with counsel would help advance prosecution, please telephone the undersigned, Appellant's attorney of record.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

LOWE HAUPTMAN HAM & BERNER, LLP



Benjamin J. Hauptman
Registration No. 29,310

1700 Diagonal Road, Suite 310
Alexandria, Virginia 22314
(703) 684-1111 BJH/KL/bjs
Facsimile: 703-518-5499
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